

REMARKS

This paper is filed in response to the office action mailed on July 2, 2004.

Claims 19, 34, 57 and 64 have been amended; claims 40-42 have been canceled; claims 1-39 and 43-68 remain pending.

In the office action, claims 1-10, 19-20, 23, 26, 49-53, 57 and 60 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,058,379 ("Odom"). In response, claims 19, 34 and 57 have been amended and applicants present the following remarks establishing the allowability of each independent claim 1, 19, 34, 49, 57 and 64 as being allowable over Odom.

At the outset, under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Citing, Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants respectfully submit that Odom fails to teach or suggest more than one limitation of each pending independent claim. Specifically, Odom fails to teach or suggest the determining of a credit relationship between a metal buyer and a metal seller as recited in independent claims 1, 19, 34, 49, 57 and 64. Second, Odom does not teach or suggest the transmitting of a metal exchange web page to a metal buyer as recited in independent claim 1, 19, 49 and 57. Finally, Odom does not teach or suggest the facilitating of a purchase of FAS133 compliant derivative contract as recited in independent claims 34 and 64.

Specifically, Odom does not recite the confirmation of any credit agreement between a buyer and or a seller. Odom is directed toward an exchange where a buyer may establish credit with an exchange but not with a specific seller. Nowhere in column 5 of Odom is the concept of checking whether a purchaser has established credit with a seller is taught or suggested. At column 12, lines 33-35, Odom does teach that a member of the exchange must have funds or a line of credit available for debiting. This recitation does not meet the determination of a preexisting credit relationship between a metal buyer and a metal seller as recited in each independent claim 1, 19, 34, 49, 57 and 64. Nowhere does Odom

teach or suggest the determination of a preexisting credit relationship. Accordingly, Odom cannot anticipate any independent claim for this reason alone.

However, Odom does not teach or suggest the transmitting of a metal exchange web page to the metal buyer as part of a transaction. Odom only remotely relates to the posting of information on the worldwide web. See dependent claim 8 in column 14 of Odom. Odom does not teach the transmission of a metal exchange web page to any participant, either buyer or seller or exchange member. Thus, Odom cannot serve as an anticipating reference for independent claims 1, 19, 49 and 57 for this additional reason.

Third, nowhere in Odom is the concept of FAS133 compliant derivative contract mentioned. Nowhere in Odom are the concepts of FAS133 compliant derivative contract along with the concept of anonymity and establishing a preexisting bilateral credit arrangement taught or suggested. Nowhere is the concept of price transparency taught or suggested in Odom as well. Thus, for these additional reasons, Odom cannot serve as an anticipating reference for independent claims 34 and 64.

Accordingly, each pending independent claim is clearly allowable over the entire Odom reference for the reasons set forth above.

Next, the office action rejects claims 34-39, 43-48, 64 and 66-68 under 35 U.S.C. § 102(a) as allegedly being anticipated by U.S. Patent No. 5,715,402 ("Popolo"). In response, independent claims 34 and 64 have been amended to traverse this rejection.

Specifically, Popolo does not even mention the word credit or the concepts of determining whether a preexisting bilateral credit agreement exists between a buyer and a seller. Thus, Popolo cannot serve as an anticipating reference of independent claims 34 and 64 for this reason alone.

Second, Popolo does not mention nor make any suggestions regarding FAS133 compliant derivative contracts. The regulation is not mentioned or addressed in Popolo.

Thus, Popolo does not teach or suggest the facilitating of a purchase of a FAS133 compliant derivative contract while maintaining the anonymity of both buyer and seller and the transmitting of an icon indicative of a preexisting bilateral credit arrangement between the buyer and the seller, all while providing the price transparency as recited in independent claims 34 and 64. Therefore, Popolo cannot serve as an anticipating reference

and applicants respectfully submit that the anticipation rejections based upon Popolo and must be withdrawn.

Next, the office action rejects claims 11-18 under 35 U.S.C. § 103 as being unpatentable over Popolo in view of Odom. Applicants respectfully traverse this rejection. Specifically, under MPEP §§ 2142 and 2143,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Citing, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Neither Popolo nor Odom teach or suggest the concept of determining whether a preexisting credit relationship exists between a buyer and a seller. Popolo makes no suggestion or credit relationships. Odom only suggests the determination of whether a buyer is credit worthy or has a credit card. Odom makes no suggestion of a credit relationship between a buyer and a seller.

Thus, no combination of Odom and Popolo teach or suggest all the limitations of claim 1 and therefore the obviousness rejection fails to establish a *prima facie* case of obviousness for at least this reason alone.

Further, no combination of Popolo or Odom teach or suggest the transmitting of a metals exchange web page to a buyer. Neither reference even remotely teaches this concept. Odom only teaches the posting of materials on the worldwide web for public notice purposes. Neither reference teaches the transmission of a web page to a buyer. Thus, the obviousness rejection fails to establish a *prima facie* case of obviousness for this additional reason.

Therefore, for at least these two reasons, the obviousness rejection cannot stand and applicants respectfully submit that all pending claims are allowable over any hypothetical combination of these two references and an early action so indicating is respectfully requested.

Next, the office action rejects claims 22, 24, 25 and 27-33 under 35 U.S.C. § 103 as being unpatentable over Popolo in view of Odom.

Applicants respectfully traverse this rejection for the same reasons set forth above with respect to claims 11-18. That is, claim 19 requires the determination of a preexisting credit relationship and the transmission of a metals exchange web page that are not taught or suggested by either Popolo or Odom. Accordingly, applicants respectfully submit that this obviousness rejection is improper and should be withdrawn.

Finally, the office action rejects claims 40-42 under 35 U.S.C. § 103 as being unpatentable over Popolo in view of Odom. This rejection is rendered moot by the cancellation of these claims and the establishment of the clear allowability of claim 34 for the reasons set forth above. That is, claim 34 recites limitations directed toward the verification of a credit relationship, the maintaining of anonymity of both buyer and seller and the price transparency step not taught or suggested by either Odom or Popolo. Accordingly, claim 34 is clearly allowable over any hypothetical combination of these two references and an early action so indicating is respectfully requested.

Accordingly, applicants respectfully submit that all pending claims 1-39 and 43-68 are clearly allowable over any hypothetical combination of Popolo and Odom and an action so indicating is respectfully requested.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

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Respectfully submitted,

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